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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,628	03/10/2000	Frederic Petit	10655.7500	5109

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Snell and Wilmer LLP
Suite 1200
1920 Main Street
Irvine, CA 92614-7060

EXAMINER

ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/522,628

Applicant(s)

PETIT, FREDERIC

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19, 27 and 34-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19, 27, 34, 35, and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.
2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
 - Claims 19 and 34 are amended.
 - Claims 1-8, 20-26, 28-33, and 37 are canceled.
 - Claims 19, 27, and 34-36 have been considered.
3. Examiner withdraws rejection of claims 1, 3, 4, 11, and 13-16 35 under U.S.C. 112 second paragraph in regards to the cancellation of the claims.
4. Pending claims are 19, 27, and 34-36 as they appear in the amendment filed in 12 September 2003. In the body of the amendment there are references to claim 1, which has been canceled by the applicant, along with claim 19. Examiner will consider claim 1 as canceled and takes this issue as inadvertent mistake by the applicant.
5. Additionally there is no mention of claim 12 in the amendments. Because claim 12 is dependent to claim 1 that has been canceled, examiner will consider claim 12 as canceled as well.

Response to Amendment

6. Applicant's arguments with respect to claims 19 and 34 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
8. Claims 19 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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9. Claim 19 recites the limitation "a public key acknowledgement..." it is not clear of how a public key can be of indication of an acknowledgement unless it is used to create a digital token or signature. Additionally whose public key is this "key"? One can use a public key to verify a digital signature or token that has been created by a private key. Private keys cannot be distributed for verification. Therefore, the examiner is lost on how an acknowledgement is created, which is meant to be secret by a public key that is generated within a device. Therefore, claim 19 is rejected under 35 U.S.C. 112 second paragraph. Clarification is requested.

10. Claim 19 recites "making...acknowledgment available..." it is not clear to the examiner how this step has been accomplished in light of the claim. It is not clear in the claim what are the steps and how this "making...available..." takes place. How is this information transferred to the information owner is taking place. It is not clear if this happens via the third party, is it done through a separate system in a later time, or is it made available to the information owner via direct contact between the information device and information owner. Clarification of this issue is requested.

11. Claim 19 recites "the validating party...". It is not clear to the examiner of whom the validating party is. Is "the validation party..." separate from any of the entity that have been mentioned, such as "the information owner", "a third party", "smart card issuer", etc. Clarification is requested.

Additionally claim 27 is rejected based on dependency on rejected claim 19.

12. Claim 34 recites the limitation "information owner". There is insufficient antecedent basis for this limitation in the claim 34. Such reference to any information owner is not present in claim 34 as it has been claimed. It is not clear to the examiner in the context of the claim who is the information owner what is the relationship among the information owner, smart card issuer, and the third party. Clarification is requested.

Therefore claims 35 and 36 are rejected based on being dependent to a rejected claim.

Claim Rejections - 35 USC § 103

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13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 19, 27, and 34-36 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,390,374 to Todd Carper in view of U.S. Patent No. 6,105,008 to Virgil M. Davis.

15. As per claim 19, Carper clearly teaches a method for an information owner to download software to an information device, over a network, wherein said information device comprises a smart card, and said method comprising the steps of:

a) the information owner delegating to a third party, download of said software to the information device; wherein said information device is capable of downloading new instruction, update existing instructions, and overwriting existing instructions (See Carper abstract figures 4-7 and 10 along with associated text and column 4, lines 6-12, column 6, lines 39-60, column 8, lines 12-58, column 10, lines 1-39, column 12, lines 49-64, and column 16, lines 43-68);

16. What is not clearly specified by Carper (See Carper column 16, lines 43-68) is how the acknowledgment is created by the information device and received and processed by the issuer. However, Davis is clearly explicate in the steps of how data in a smart card can be manipulated and changed as well as creating an acknowledgement of such change and manipulation by the smart card as well as considering the security implications of such acknowledgement (See Davis figure 18A-D and associated text, and column 26, lines 46-56). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine concepts of Carper and Davis to achieve a more secure and reliable method, which would be directly from the card itself for such transmission of an acknowledgment.

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17. It should additionally be noted that transmission of an acknowledgment from a remote device to an owner of data transmitted via a network to the remote device in order to inform the entity of certain data transmission success is a routine practice in the art. It is done in many different form insecure or none-secure manners.

18. As per claim 27, Carper and Davis disclose all the limitations of claim 19, further;
Carper clearly discloses,

- wherein said software comprises an applet (See Carper column 10, lines 1-39).

19. As per claim 34, Carper discloses a system for allowing a smart card issuer to securely delegate to a third party the download of an applet to a smart card over a network, said system comprising:

- b) an external device associated with said third party,
- c) said external device capable of transferring said applet to said smart card,
- d) wherein said applet is associated with said issuer and said applet is transferred by said third party as delegated by said information owner, said information device capable of downloading new instruction, update existing instruction, and overwriting existing instructions (See Carper abstract figures 4-7 and 10 along with associated text and column 4, lines 6-12, column 6, lines 39-60, column 8, lines 12-58, column 10, lines 1-39, column 12, lines 49-64, and column 16, lines 43-68);

20. What is not clearly specified by Carper (See Carper column 16, lines 43-68) is how the acknowledgment is created by the information device and received and processed by the issuer. However, Davis is clearly explicate in the steps of how data in a smart card can be manipulated and changed as well as creating an acknowledgement of such change and manipulation by the smart card as well as considering the security implications of such acknowledgement (See Davis figure 18A-D and associated text, and column 26, lines 46-56). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine concepts of Carper and

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Davis to achieve a more secure and reliable method, which would be directly from the card itself for such transmission of an acknowledgment.

21. It should additionally be noted that transmission of an acknowledgment from a remote device to an owner of data transmitted via a network to the remote device in order to inform the entity of certain data transmission success is a routine practice in the art. It is done in many different form insecure or none-secure manners.

22. As per claims 35 and 36, Carper and Davis disclose all the limitation of claim 34, further; Carper is not specific on the issue of what type of security is used (See Carper column 16, lines 43-68).

23. However Davis clearly discloses the specifics of what the applicant claims to be an inventive step. It would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine concepts of Carper and Davis to achieve a more secure and reliable method, which would be directly from the card itself for such transmission of an acknowledgment.

24. It should additionally be noted that transmission of an acknowledgment from a remote device to an owner of data transmitted via a network to the remote device in order to inform the entity of certain data transmission success is a routine practice in the art. It is done in many different form insecure or none-secure manners.

- acknowledgment process utilizes a symmetrical DES algorithm based on said cryptographic key (See Davis column 19, lines 31-68, column 20, lines 1-68, and column 21, lines 1-27).
- DES algorithm is a triple-DES algorithm (See Davis column 19, lines 31-68, column 20, lines 1-68, and column 21, lines 1-27).

25. Moreover it is understood that Carper and Davis clearly disclose the claimed invention, as discussed above, except for the step of utilizing a symmetrical triple DES encryption algorithm using a public key for verifications. It would have been an obvious step to combine teachings of Carper and Davis, to provide the step of utilizing a symmetrical triple DES encryption algorithm using a public key for verifications, since applicant has not disclosed that if this method in particular solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill

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and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Carper and Davis will perform the invention as claimed by the applicant with any method, means or product to verify the encrypted acknowledgment .

26. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner. It should be noted that a reference is to be considered not only for what it expressly states, but also for what it would reasonably have suggested to one of ordinary skill in the art. *In re DeLisle*, 160 USPQ 806 (CCPA 1969).

Conclusion

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

28. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be

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reached on 9:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

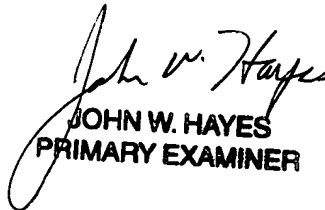
(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

**Abdi/K
November 25, 2003**


**JOHN W. HAYES
PRIMARY EXAMINER**